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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389	7590	05/20/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			PHAN, HUY Q	
			ART UNIT	PAPER NUMBER
			2685	10

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on Date: Apr. 14, 2004.
Claims 1, 3-21 and 23-27 are still pending.
Claims 2 and 22 are cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3-21 and 23-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-13, 15-20 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Molne (US-5,999,811).

Regarding claim 1, Molne discloses in figure 1, a method of facilitating handover from an active network (28) with which User Equipment (32) is in communication to another network (30) (col. 7, lines 9-16), the method comprising the steps of: providing

a list of available other networks to said User Equipment via the active network (col. 4, lines 21-24 and col. 3, lines 46-51); in the User Equipment, selecting among the available networks based on preference information and signaling to said active network at least one preferred other network (col. 3, lines 31-32); and providing neighbor cell information for the at least one preferred other network to said User Equipment via the active network (col. 3, lines 21-27).

Regarding claim 3, Molne discloses in figure 1, a method of facilitating handover from an active network (28) with which User Equipment (32) is in communication to another network (30) (col. 7, lines 9-16), the method comprising the steps of: receiving from User Equipment communicating via the active network an indication of at least one preferred other network (col. 3, lines 21-24 and col. 3, lines 46-51); and in response thereto, providing neighbor cell information for the at least one preferred other network (col. 3, lines 24-27).

Regarding claim 4, Molne discloses in figure 1, a method of operating User Equipment (32) capable of handover (col. 7, lines 9-16) between an active network and another network comprising storing in the User Equipment a list of available networks based on information supplied by the active network with which the User Equipment is in communication (col. 3, lines 46-51 and col. 3, lines 1-30) and transmitting from the User Equipment an indication of a preference for a network (col. 3, lines 27-32).

Regarding claim 5, Molne discloses a method as recited in the rejection of claim 4, further comprising a step of incrementally adding to or subtracting from the list of available networks (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 6, Molne discloses in figure 1, a method of facilitating handover from an active network with which User Equipment is in communication to another network (col. 7, lines 13-16), the method comprising providing a list of available other networks to said User Equipment via the active network (col. 3, lines 21-24 and col. 3, lines 46-51); and sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 7, Molne discloses in figure 1, a method of operating an active network to facilitate handover to another network (col. 7, lines 9-16) comprising: maintaining a connection via the active network with a User Equipment (col. 3, lines 21-32); and a step of providing to the User Equipment communicating via the active network a message containing information for incrementally adding to or subtracting from a stored list of available networks (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 8, Molne discloses in figure 1, a method of operating User Equipment capable of handover between an active network and another network (col. 7,

lines 9-16) comprising: storing a preference for a network; and a step of incrementally adding to or subtracting from a stored list of available networks based on information supplied by the active network with which the User Equipment is in communication (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 9, Molne discloses in figure 1, a method of operating User Equipment capable of handover between an active network and another network (col. 7, lines 9-16) comprising: storing a preference for a network; and a step of signaling to the active network with which the User Equipment is in communication the preferred other network for handover (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 10, Molne discloses a method as recited in the rejection of claim 9, wherein said preferred other network is selected by the User Equipment from a list of available networks supplied by the network (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 11, Molne discloses in figure 1, a method of operating an active network with which User Equipment is in communication comprising: maintaining a connection via the active network with a User Equipment (col. 3, lines 21-24); and a step of sending neighbor cell information to User Equipment based on network preferences communicated by the User Equipment (col. 3, lines 24-27).

Regarding claim 12, Molne discloses a method as recited in the rejection of claim 11, further comprising a step of sending mutually different neighbor cell information to mutually different User Equipments based on mutual different network preferences (col. 3, lines 21-31).

Regarding claim 13, Molne discloses a method as recited in the rejection of claim 1, wherein the preferred other network is selected based on information stored in the User Equipment, preferably in a SIM card (fig. 2, box 41) (col. 3, lines 46-51).

Regarding claim 15, Molne discloses a method as recited in the rejection of claim 1, wherein the active network is provided by an active network provider and the other network is selected from networks provided by other network providers (col. 7, lines 9-16).

Regarding claim 16, Molne discloses in figure 1, a User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising means for storing a list of available 5 other networks supplied by the active network (fig. 4); and means for transmitting from the User Equipment an indication of preference for a network (col. 3, lines 21-32).

Regarding claim 17, Molne discloses a User Equipment as recited in the rejection of claim 16, further comprising means for updating the stored list of available other networks based on information supplied by the active network (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 18, Molne discloses in figure 1, a User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network (col. 7, lines 9-16) comprising: means for updating a stored list of available other networks based on information supplied by the active network (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54); and means for transmitting from the User Equipment an indication of preference for a network (col. 3, lines 21-45).

Regarding claim 19, Molne discloses in figure 1, a User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising: a storage unit configured to store a preference for a network (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54); and means for signaling the preferred other network to the active network during a call (col. 3, lines 21-51).

Regarding claim 20, Molne discloses a User Equipment as recited in the rejection of claim 19, further comprising means for storing network preference information (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 23, Molne discloses in figure 1, a mobile communications network or component thereof comprising: communicator configured to communicate to User Equipment communicating with the network a list of available other networks (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54); and means for sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 24, Molne discloses in figure 1, a mobile communications network or component thereof including: means for maintaining a connection via the active network with a User Equipment (col. 3, lines 1-55); and means for sending a message to the User Equipment containing information for incrementally adding to or subtracting from a list of available networks stored in the User Equipment (fig. 4; col. 3, lines 46-51 and col. 7, line 30-col. 9, line 54).

Regarding claim 25, Molne discloses in figure 1, a mobile communications network or component thereof including means for receiving from User Equipment communicating with the network an indication of a preferred other network (fig. 4; col. 3,

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lines 46-51 and col. 7, line 30-col. 9, line 54); and means for supplying neighboring cell information for the preferred other network based on the indication (col. 3, lines 21-31).

Regarding claim 26, Molne discloses in figure 1, a mobile communications network or component thereof including: means maintaining a connection via the active network with a User Equipment (col. 3, lines 21-32); and means for sending neighbor cell information to the User Equipment based on network preferences communicated by the User Equipment (col. 3, lines 21-32).

Regarding claim 27, Molne discloses a mobile communications network or component as recited in the rejection of claim 26, further arranged to send mutually different neighbor cell information to mutually different User Equipments based on mutually different network preferences (col. 5, line 61-col. 7, line 39).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne.

Regarding claims 14 and 21, Molne discloses a method as recited in the rejection of claims 1 and 16 respectively. But Molne fails to particularly show wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. However, the examiner takes official notice that Universal Mobile Telecommunication System (UMTS) network and Global System for Mobile Communication (GSM) network are extremely well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Molne by specifically having the active network being a UMTS network and the other network being a GSM network, having means for communicating over both networks for purpose of implementing the method of handover between two well known networks in order to improve the quality and reliability of wireless communications service.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Schiefer et al. (US-5,884,175) disclose handover in a mobile radio system.
- b) Kozdon et al. (US-5,594,781) disclose mobile telephone connection transfer.
- c) Hagting et al. (US-6,236,860) disclose handover in a radio communications system.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 703-305-9007. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Urban F Edward can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Huy Phan

AU: 2685

May 14, 2004


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600